

1 **IN THE U.S. PATENT AND TRADEMARK OFFICE**

2
3 **U.S. Appln. No:** 10/549,649

Confirmation No: 6172

4 **Applicant:** Hubbard, et al.

5 **Title:** System for Measuring and Indicating the Changes
6 in the Resistance of a Living Body

7 **Atty. Dkt. No.** ASI/1400(US)

8
9 **Entry Into US National Phase of:**

10 International Application No. Serial No: US2004/006084

11 International Filing Date: 19 March 2004

12
13 Commissioner of Patents

14 P.O. Box 1450

15 Alexandria, VA 22313-1450

16
17 **PETITION TO REVIVE AND TO REFUND PETITION FEE**

18
19 Dear Sir,

20 Applicant respectfully petitions to revive the above-captioned application from a holding
21 of abandonment, and to refund the petition fee paid herewith, because the application has not
22 been abandoned. As described below, the holding of abandonment appears to be contrary to the
23 express provisions set forth in the November 17, 2006 Decision in this case (hereinafter, the
24 Decision). If the holding was improper, refund of the Petition Fee is requested.

25 If the holding was proper, the abandonment was unintentional, revival remains
26 appropriate, and favorable consideration is respectfully requested.

27 This petition is accompanied by the proposed response and the requisite fee. The
28 proposed response consists of a Renewed Petition Under 37 CFR 1.47(a) and the Declaration of
29 Norman F. Starkey on behalf of deceased inventor Hubbard.

BACKGROUND

On May 2, 2006, a Notice of Missing Requirements Under 35 U.S.C. 371 (the Notice) was mailed by the PTO advising that an Oath or Declaration of the inventors failed to comply with 37 CFR 1.497(a) and (b). Specifically, the Notice pointed out that the signatures of deceased inventor Hubbard and inventor Lillihaugen were missing, and that the citizenship and residence of deceased inventor Hubbard was also missing.

On October 17, 2006 applicant filed a response that included (a) a Petition to make application without the signature of inventor Lillihaugen and (b) a replacement page for the Hubbard Declaration showing Mr. Hubbard s last residence and citizenship.

On November 17, 2006 the Decision was mailed advising that a complete Declaration on behalf of deceased inventor Hubbard needed to be filed with specified information concerning both Mr. Hubbard and the person signing on his behalf.

The Decision required a response to be filed within two months and explicitly stated:
Extensions of time may be obtained under 37 CFR 1.136(a). (Decision, pg. 3, ¶1).

ARGUMENT

The Decision required a response to be filed within two months and explicitly stated that [e]xtensions of time may be obtained under 37 CFR 1.136(a). Section 1.136(a) provides:

(a)(1) If an applicant is required to reply within a nonstatutory or shortened statutory time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set in §1.17(a) are filed, unless:

(i) Applicant is notified otherwise in an Office action;

(ii) The reply is a reply brief submitted pursuant to §41.41 of this title;

(iii) The reply is a request for an oral hearing submitted pursuant to §41.47(a) of this title;

(iv) The reply is to a decision by the Board of Patent Appeals and Interferences pursuant to §1.304 or to §41.50 or §41.52 of this title; or

(v) The application is involved in a contested case (§41.101(a) of this title).

The exceptions set forth in Rule 1.136(a)(i-v) are clearly not applicable.

1 Thus, a fair reading of the Decision was that a response needed to be filed within two
2 months (i.e., by January 17, 2007) and extensions could be obtained under Rule 1.136(a) to the
3 earlier of the expiration of any maximum period set by statute (hereinafter, the maximum
4 statutory period) or to five months after the time period set for reply (hereinafter, the Five
5 Month Period).

6 First, the extension deadline could not have been determined by the maximum statutory
7 period attributable to the Notice. The Notice was mailed on May 2, 2006, and a response to the
8 Notice was filed on October 17, 2006 within the maximum statutory period. Moreover, by the
9 time the Decision issued on November 17, the maximum statutory period for responding to the
10 May 2 Notice had expired. It had ended on November 2, 2006. Thus, there was no period
11 within which to further reply if that was the operative response period. Further, Rule 136(a)
12 would be inapplicable since the expired maximum statutory period was earlier than the
13 alternative Five Month Period available under the Rule. The fact that Rule 136 was recited by
14 the Decision shows that the Notice was not the operative document in setting the response
15 deadline.

16 Accordingly, the applicable response deadline must necessarily have referenced the
17 Decision s issue date of November 17, 2006. The decision set a response period two months
18 (i.e., to January 17, 2007) and stated that extensions were available under Rule 1.136(a). As
19 stated above, Rule 136(a) provides for an extension of up to the maximum statutory period of
20 May 17, 2007 (i.e., six months from the Decision s issuance) and the Five Month Period (June
21 17, 2007). Thus, the earlier maximum statutory of May 17, 2007 was operative and the holding
22 of abandonment was premature.

23 It is thereby submitted that the holding of abandonment was incorrect, and
24 reimbursement of the Petition Fee to Deposit Account 01-2529 is respectfully requested.

25 //

26 //

27 //

28 //

29 //

